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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,233	02/07/2002	David L. Briese	DN 1460	2299

7590 08/27/2004

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EXAMINER
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BERGIN, JAMES S

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No

10/072,233

Applicant(s)

BRIESE, DAVID L.

Examiner

James S. Bergin

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The Information Disclosure Statement filed 2/7/2002 was considered and signed by the previous examiner, Harold Tudor, and mailed out to the applicant as an attachment to the office action mailed on 3/20/2003 (paper 6). The current examiner responsible for this case has noted that this Form 1449 is now missing from the file. The office kindly requests that the applicant's forward a copy of the Form 1449 signed by the previous examiner or an unsigned copy of the original form, for entry in the file and consideration by the current examiner.

### ***Claim Objections***

2. Claim 7 is objected to because of the following informalities: in line 13, the typographical error "on half" should perhaps be replaced with one half. Correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "(low shear modulus)" in claim 1 is a relative term, which renders the claim indefinite, and one of ordinary skill in the art would not be reasonably appraised of

the scope of the invention. What is considered a low shear modulus to one individual might not be considered low by another individual.

***Response to Amendment***

5. The Declaration under 37 CFR 1.132 filed 2/24/2004 is insufficient to overcome the rejection of claims 1, 2, and 4-7 based upon Briese (US 5,528,989 A) in view of the British patent to Weiss (GB 0011087) as set forth in the last Office action because: although the Declaration does compare the penetration and impact fragmentation of the David Briese Shear Fragmentation Bullet (the instant invention) with that of the Torrey Briese bullet and the Hornady bullet, it does not offer any opinion on the bullet of Weiss (GB 0011087), or the teaching of Weiss, which has been used to modify the bullet of Briese '989 in the rejection noted above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briese (US 5,528,989 A) in view of Weiss (GB 0011087).

Briese discloses the invention substantially as claimed. However, Briese does not disclose a separable bullet comprising a core formed of a plurality of helically twisted malleable strands of metal. Weiss teaches forming the core of a separable bullet of a plurality of helically twisted strands of metal to control the fragmentation of

the bullet without appreciable ricocheting. To replace Brieese's bullet core with a core comprising a plurality of helically twisted metal strands so as to control the fragmentation of the bullet without appreciable ricocheting, as taught by Weiss, would have been obvious to one having ordinary skill in the art at the time that the invention was made. It would further have been obvious to one having ordinary skill in the art at the time that the invention was made to vary the pitch of the twisted strands to achieve a desired result since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Applicant's arguments filed 12/17/2003 have been fully considered but they are not persuasive. The applicant argues that: *"Furthermore, in the absence of any 'substantial evidence' of record, there is no indication in Brieese or in Weiss that the combination of the two references could be used to achieve the effect of the applicant's invention."* In response to this argument the examiner notes that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this instance the examiner believes that a bullet having the structure of the Brieese bullet as modified by Weiss, as discussed above, would be capable of performing the intended use of the bullet of the instant application.

**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schultz (US 6,024,021 A) comprises a relevant fragmenting bullet comprising a core made from compressed irregularly shaped lead rods.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday - Wednesday and Friday, 8.30 - 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James S. Bergin



JACK KEITH  
PRIMARY EXAMINER